

### **REMARKS/ARGUMENTS**

The final office action of November 03, 2009 (“Office Action”), has been carefully reviewed and these remarks are responsive thereto. Claims 1-6, 8-16, 18-20, 22-36, and 38-40 have been amended, and claim 23 and 37 has been canceled without prejudice or disclaimer. Claims 1-6, 8-16, 18-20, 22, 24-36, and 38-40 thus remain pending in this application upon entry of this amendment. Support for the added features of memory and computer readable instructions may be found in Applicant’s specification on page 31 lines 19-22. No new matter has been introduced with these amendments. Reconsideration and allowance of the instant application are respectfully requested.

#### **Personal Interview**

Applicant wishes to thank Examiner Shelehedra for the courtesies extended to their representative during the personal interview on January 7, 2010. During the interview Applicant’s representative and Examiner Shelehedra tentatively agreed that the combination of Kassatly and Saeger failed to teach the claim limitation of a “video channel including a split screen with multiple video clips positioned in different portions of the split screen.” Applicant’s representative agreed to submit formal remarks on this point, which are included below.

Examiner Shelehedra directed Applicant’s representative to Justice et al., U.S. Pat. No. 3,953,666, hereinafter Justice, which allegedly discloses the video channel including the split screen features. Applicant addresses Justice below.

#### **Rejections under 35 U.S.C. 103(a)**

Claims 22, 23, 33, and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Banker et al. (U.S. Pat. No. 5,477,262), in view of Kassatly (U.S. Pat. 4,975,771), and in view of Saeger et al (U.S. Pat. No. 5,467,144).

Claims 8-16 and 18-20, 29, and 30 stand rejected under 35 U.S.C 103(a) as being unpatentable over Banker, in view of Gibson (U.S. Pat. No. 5,539,871), in view of Kassatly, and in view of Saeger.

Claims 1-6, 24-26, 37, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (U.S. Pat. No. 5,410,326), in view of Kassatly, and in view of Saeger.

Applicant respectfully traverses these rejections.

Independent claims 1, 8, 22, and 24 each recite the feature of a “[received] video channel including a split screen with multiple video clips positioned in different portions of the split screen.” The Office Action points to a combination of Kassatly and Saeger for this feature.

As alleged by the Office Action, Kassatly discloses a plurality of digitally compressed video programs (or clips) transmitted on a single channel, and Saeger discloses a television system which displays a plurality of video signals utilizing a split screen technique. See Office Action, page 4. Even assuming that Kassatly and Saeger disclose the features alleged by the Office Action, which Applicant does not concede, the combination fails to disclose the features of the independent claims which recite that the video channel including the split screen with multiple video clips positioned in different portions of the split screen is received. Kassatly merely discloses that multiple video programs are in a single channel without indicating the multiple video programs are positioned in different portions of the split screen of the channel. Saeger merely discloses combining and displaying separately received video signals arranged in a split screen. The fact that Saeger discloses how to combine and display different videos in a split screen does not teach or suggest modifying Kassatly such that the transmitted single channel includes a split screen to begin with. At most, the combination of Kassatly and Saeger would result in a system which receives the multiple videos from the single channel in Kassatly, and combines the videos into a split screen display after being received as disclosed in Saeger.

Indeed, Saeger teaches away from the claims by displaying multiple videos together, as opposed to displaying a single video as recited in the claims. Stated another way, Saeger teaches the opposite process with a different result as compared to the claims by taking videos which are formatted separately when received and combining them after being received into a split screen to be displayed together, rather than receiving videos already combined into a split screen format when received, but displaying one of the vid.eos after being received.

Because the combination fails to teach all of the features of the claims and because Saeger teaches away from the claims, claims 1, 8, 22, and 24 and claims 2-6, 9-16, and 18-20, which depend on one of claims 1, 8, 22, and 24, are allowable over the cited references, individually or in any permissible combination. Withdrawal of the rejection is respectfully requested.

**Justice et. al.**

Applicant has reviewed Justice, which was discussed during the personal interview and which is alleged to disclose the claim feature of a “video channel including a split screen with multiple video clips positioned in different portions of the split screen.” Applicant respectfully submits that Justice is non-analogous art, and one of skill in the art would have no apparent reason to combine Justice with the other cited references.

Justice discloses an analog television system used in an educational system for transmitting and receiving a signal having four different pictures presented in four quadrants of a television receiving tube. See Justice, Abstract. The four pictures are presented together as four possible answers to a multiple choice question in which a pupil may select one of the pictures as the correct answer. See *Id.* col. 1 lines 7-42. Based on the pupil’s selection, the selected quadrant may be centered and amplified to fit the entire television receiving tube face. See *Id.*, col. 2 lines 6-11.

As an initial matter, before Justice could be combined with Banker or Gibson, Justice would have to be analogous art, which requires Justice to be in the same field of endeavor, or reasonably pertinent to addressing a known need or problem in the field of endeavor. See *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant’s claims pertain to generating and presenting menus and electronic program guides. Banker and Goldstein, as well, allegedly disclose electronic program guides. Justice, in contrast, discloses an educational television system for presenting information to students. Applicant respectfully submits that no need or problem known in the field of electronic program guides would have led one of ordinary skill in the art, at the time Applicant’s filling date, to investigate the field of educational television systems for solutions.

Moreover, even if considered analogous and relevant to showing technical knowledge, in the art, of being able to receive multiple pictures in a split screen, no apparent reason exists to combine Justice with Banker or Goldstein. Applicant's claims cannot be shown to be obvious merely by demonstrating that each of the claim elements was independently known. See KSR, 550 U.S. at 418 (2007). The Supreme Court in KSR explained that inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. See *Id.* In this case, Justice had been published for over twenty five years before Applicant's application was filed without anyone, to Applicant's knowledge, applying a split screen channel to an electronic program guide in the manner alleged. Any reason which the examiner might put forth to apply Justice to menus and electronic program guides could not be considered "apparent" when no one has realized such a reason in a quarter of a century.

Further to this point, the Office Action alleges that it was notoriously well known in the art to present menus with scaled down video programming (Office Action, page 10). So according to the Office Action, menus including a video were well known without the additional claim feature of receiving the video in a "video channel including a split screen with multiple video clips positioned in different portions of the split screen." No reason is taught or suggested in Banker or Goldstein or is apparent from what is known in the art for adding this claim feature. Justice also does not disclose a reason for combining the references. As disclosed in Justice, the four quadrants of the display are intended to be presented together in an educational system for providing the viewer with multiple choice answers to a question. It does not follow that because a viewer can center and amplify one of the choices in Justice, that one of skill in the art would be led to include such features in a menu as now alleged. Justice simply does not consider or relate to menus and provides no reason or benefit for including its features in a menu of an electronic program guide.

The reasons previously put forth for combining Kassatly with Banker and Goldstein would also fail if applied to Justice. The Office Action asserts that it would be obvious to combine a split screen channel with the program guides of Banker and Goldstein for the "typical benefit" of more efficiently utilizing bandwidth by allowing a single channel to transmit

additional video information (Office Action, pages 4 and 14-15). The Office cannot simply assert that a reason to combine references is “typical” without some support on the record that the benefit was known to those skilled in the art. The only reference the Office has been able to put forth that allegedly discloses a split screen channel is Justice, filed in 1973, which does not teach or suggest an efficiency gain in its system. Indeed, Justice’s stated purpose for providing four pictures on a screen is to present answers to a multiple choice question, which is entirely different than the Office’s alleged benefit of improving efficiency. No support is provided that supports the Office’s “typical benefit” reason to combine the references in the manner alleged.

But even if the Office could show with other evidence that one of skill in the art would come to realize an efficiency benefit in the old analog system in Justice, such an efficiency benefit is not necessarily realized or applicable in the digital systems presented in Banker and Goldstein. Such digital systems could provide improved efficiency by, for example, sending a video at a lower resolution, which is not in a split screen, or the digital system could send the video in a compressed format. One of skill in the art would be inclined to apply techniques adapted to the digital system, rather than reaching back to inapplicable analog techniques as taught in Justice. For example, by the Office’s own assertion, Kassatly (which was filed before Goldstein and Banker) provides an efficiency gain by transmitting multiple video programs in a single channel, but as agreed during the interview, Kassatly does not include the multiple video programs positioned in different portions of the split screen of the channel. Positioning the videos into a split screen in the digital system of Kassatly would do nothing to improve efficiency. In contrast, the only way to transmit more than one video in a channel in the old analog system of Justice is to generate a composite image of the videos (See Justice col. 2 lines 53-65). The techniques in Justice are necessarily tied to the technology of the time, and don’t translate to the digital systems in Banker and Goldstein. An efficiency benefit would not be realized if Justice were to be combined in some permissible manner with Banker or Goldstein, and accordingly would not support a reason to combine the references.

It appears that the only reason to combine Justice (or any split screen technique for that matter) with the electronic program guides of Banker and Goldstein results from Applicant’s

own disclosure, not teachings gleaned from the prior art as a whole. Accordingly, a rejection based on Justice combined with Goldstein or Banker would be improper.

**Non-Statutory Double Patenting Rejection of Claim 24 Based on U.S. 6,515,680**

Claim 24 stands rejected under the non-statutory judicially created doctrine of double patenting over U.S. Pat. No. 6,515,680. Claim 24 has been amended to incorporate the features of claim 37. Applicant submits that the rejection is now moot, and respectfully request the rejection be withdrawn.

**Non-Statutory Double Patenting Rejection of Claims 1, 8, 22, and 24-40**

Claim 1, 8, 22, and 24-40 stand rejected under the non-statutory judicially created doctrine of double patenting over U.S. Pat. No. 7,363,645.<sup>1</sup> Applicant respectfully traverses this rejection. The Office Action has conceded that the claims are not identical. The Office has the burden of presenting reasons why a person of ordinary skill in the art would conclude that the admitted differences between the claims of the '645 patent and the rejected claims would have been obvious. See MPEP 804(II)(B)(1). The Office Action has not provided any reasons why the claims would have been obvious, and thus has not met its burden. Further, Applicant has substantially amended the rejected claims, and thus believes the rejection to be nonetheless moot.

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<sup>1</sup> The Office Action cites U.S. Patent No. 7,373,645. Since the cited patent is an unrelated patent which is not commonly owned, Applicant assumes the Office Action intended to cite U.S. Patent No. 7,363,645, which was disclosed in Applicant's previous response submitted on August 26, 2009.

**CONCLUSION**

All the rejections having been addressed herein, Applicant submits that the claims are in condition for allowance. The Examiner is invited to contact the undersigned attorney to expedite to advance prosecution of the application.

Respectfully submitted,  
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